

PATENT  
6990-1003

a plurality of holes positioned within coined spacers  
~~said pair of sides and adapted to receive axles for skate wheels.~~

2. (Twice Amended) The chassis recited in claim 1 further  
including flat, annular surfaces on said coined spacers. [ ; ]  
[means for spacing the skate wheels between said  
sides.]

Please cancel claim 3.

## II. REMARKS REGARDING AMENDMENTS

Claim 1 has been amended to include the subject matter of claim 3. Claim 3 has been canceled and claim 2 has been amended to include further detail regarding the coined spacers.

The present application is now under final rejection, with all rejections having been made on the basis on a newly cited reference, i.e., U.S. Patent No. 5,513,861 ("'861"), to Monroy, et al. Applicants were previously unaware of the Monroy reference, and in this reply, provide additional amendment and argument that will clearly render the pending claims patentable over all references of record.

Specifically, in this regard, the sole factual issue for consideration is whether the Monroy reference teaches "coined" spacers in an inline skate frame. As will be shown, the Monroy

**PATENT  
6990-1003**

reference is limited to "machined" spacers, and affirmatively teaches away from "coined" spacers. As is well known, the physical properties of shapes formed by these two distinct processes are quite different. Furthermore, there is no teaching or suggestion in the prior art of record to have modified or made the Monroy skate frame spacers in a coining process as disclosed and claimed in the present application, rather than in a machining process as taught in Monroy.

No new matter has been added by any amendment.

**III. REPLY TO REJECTION OF CLAIMS 1-5, 7 AND  
13-15 UNDER 35 U.S.C. §102(b)**

Claims 1-5, 7 and 13-15 have been rejected under 35 U.S.C. §102(b) as being anticipated by Monroy, et al '861. The discussion at column 3, lines 48-59 of Monroy, referring to formation in the vertical sides by "extruding" was relied on in the Office Action as a teaching that the Monroy spacers, referred to as "buses" are "coined".

It is noted that the rejection was applied to previous claim 3, and 13-15, all of which expressly required that the apparatus be "coined". Upon citation of Monroy '861, claim 3 was canceled and its subject matter was incorporated into independent claim 1. As a result, all pending claims now require the apertures or spacers to be "coined". Thus, the only issue presented under

PATENT  
6990-1003

Section 102 is whether Monroy, et al '861 does, in fact, disclosure apertures or spacers that are "coined".

In reply, Applicants acknowledge that Monroy, et al, at column 3, lines 48-59, does disclose that the frame 30 is fabricated from an appropriate length of "extrusion". However, with respect to the structures referred to as "bosses 120", (which structure corresponds to the structure referred to as "spacers" in the present application and claims) those structures in Monroy are made solely by a machining process, and are therefore, properly termed as "machined" busses or machined spacers. Specifically, at column 4, lines 39-44, Monroy states that:

"In both Figs. 6 and 7, one can see in phantom portions of bosses 120 that surround the through-apertures 100, 102 on the inside surfaces of the walls 36, 38. These bosses have been created from the thickened lower margins 82, 84 of extrusion 34 by selective machining."

As shown above, these prior art structures are machined structures, rather than "coined" structures. In sharp contrast, the specification of the present invention provides that the

**PATENT  
6990-1003**

structures are "coined", as opposed to machined. In this regard, reference is made to various places in the specification, such as page 2, line 28 through page 3, line 1; page 4, lines 14-15; page 6, lines 4-10; page 7, lines 24-26; and page 9, lines 13-19. There it is pointed out that the spacers of the present invention are coined, preferably, at a predesignated point during the manufacturing process, which includes other forming steps such as punching and bending.

Furthermore, as described in standard references, copies of which are submitted herewith, it is well-known that a "coining" process is a particular type of extrusion process, in which the metal, while cold, is made to flow, under very high pressure, into a specific form. Because of the high pressures involved, the resulting, coined structure has different physical properties, than do structures made from either a "hot" extrusion process, or from a machining process. In particular, a coined structure is harder than the original metal from which it was "coined" and harder than the same shaped structure, if "hot" extruded and/or "machined".

For example, as explained in Die Designing and Estimating, Compiled and Edited by Watson N. Nordquist, Fourth Edition, Exhibit "A" submitted herewith, coining is listed as one of several specialized production processes, and described as:

PATENT  
6990-1003

"Coining dies compress the metal, causing it to flow into depressions in the punch and die faces. This hardens and toughens the metal, as well as changing it dimensionally." [Emphasis added]

In this reference, coining dies are compared to extrusion dies, in which no reference is made to compression or hardening of the metal. Id.

Similarly, in the Tool and Manufacturing Engineers Handbook, David B. Dallas, Editor-in-Chief, Third Edition, Exhibit "B" submitted herewith, the coining process is described and the advantages of parts produced by coining are explained as follows:

"The advantages of parts produced by coining are dimensional accuracy, polished surfaces, increased strength, and economy in material and many activity." [Emphasis added]

Accordingly, "coined" spacers, which bare the brunt of the forces from the wheels during use of the skate, are better able to withstand these forces than are skate frames in which such structures are merely "machined".

Careful review of the Monroy, et al '861 reference indicates that there is no express disclosure of any other process by which the "busses 120" were formed, and there is no suggestion whatever

PATENT  
6990-1003

that these busses may be made by any other process. Accordingly, not only is the Monroy '861 reference deficient in disclosing the subject matter as presently claimed, it provides no suggestion whatever for a modification in the sense that the busses 120 could have been formed by any other process.

IV. **REPLY TO REJECTION OF CLAIMS 8  
AND 16-17 UNDER 35 U.S.C. § 103(a)**

Claims 8 and 16-17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Monroy, et al '861 in view of U.S. Patent No. 5,735,536 ("'536") to Robert Myers.

The Office Action relies on Monroy '861 as teaching substantially all of the claimed subject matter, including "coined" spacers, except for the "embossment". An embossment is asserted to be found in Myers, and it is asserted that Myers suggests modification to a skate frame by including an embossment.

In reply, Applicants would note that all of claims 8 and 16-17 require that the spacers be "coined" spacers, and, for the reasons discussed in detail above, all such claims are patentable over the references of record. Accordingly, Applicants request that the rejection to claims 8 and 16-17 be withdrawn for the same reason.

## FAX RECEIVED

FEB 01 1999

CPDHP 3600

PATENT  
6990-1003

V.

REPLY TO REJECTION OF CLAIM 9  
UNDER 35 U.S.C. § 103(a)*Official*

Claim 9 has been rejected under 35 U.S.C. §103 as being unpatentable over Monroy, et al. '861 in view of U.S. Patent No. 5,470,085 to Mebock ("'085"). The Office Action asserts that Monroy et al teach substantially all of the claimed subject matter except a gussett, which is supposedly taught by Mebock '085.

In reply, Applicant would point out that claim 9 depends from claim 1 and is patentable for the same reasons as is claim 1, i.e., it requires "coined" spacers.

VI.

CONCLUSION

For all of the above reasons, it is respectfully requested that all rejections be withdrawn, and a notice of allowance be issued.

Respectfully submitted,

  
Jon E. Hokanson,  
Reg. No. 30,069  
Attorney for Applicant

Dated: February 1, 1999

SMALL LARKIN, LLP  
10940 Wilshire Boulevard  
Eighteenth Floor  
Los Angeles, California 90024-3945  
Tel: (310) 209-4499  
Fax: (310) 209-4450